

The opinion in support of the decision being entered today was **not** written for publication in a law journal and is **not** binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BERNARD PARISI and DAVID J. BURKE

Appeal No. 2000-0303
Application No. 08/886,649

ON BRIEF

Before COHEN, NASE, and GONZALES, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection (Paper No. 14, mailed February 5, 1999) of claims 17, 18 and 21 to 27.¹ Claims 28 to 30 have been allowed. Claims 1 to 16, 19 and 20 have been canceled.

We REVERSE.

¹ Claims 18 and 27 were amended subsequent to the final rejection.

BACKGROUND

The appellants' invention relates to a strainer for a drain assembly (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Stretch 1898	596,763	Jan. 4,
Ficener 1906	838,702	Dec. 18,
Pasman 1938	2,107,126	Feb. 1,
Shobe 1955	2,698,441	Jan. 4,

Claims 17 and 21 to 26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Stretch in view of Pasman and Shobe.

Claims 18 and 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Stretch in view of Pasman and Shobe as

applied to claims 17 and 25 above, and further in view of Ficener.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 21, mailed June 25, 1999) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 18, filed March 19, 1999) and reply brief (Paper No. 22, filed August 2, 1999) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 17, 18 and 21

to 27 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

All the claims under appeal recite a strainer for a drain assembly comprising, inter alia, a cup-shaped body having an upstanding smooth uncorrugated outer peripheral wall, a floor, and an upraised central portion having an inner peripheral wall and a top surface; a plurality of slots in the outer peripheral wall for draining water; a plurality of slots in the floor for draining water; a plurality of slots in the

inner peripheral wall for draining water; and a plurality of openings in the top surface of the central portion.

It is our view that these limitations are not suggested by the applied prior art. In fact, our review of the examiner's rejection reveals that the examiner never did determine that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have arrived at the claimed subject matter. In that regard, it is clear to us from the answer (pp. 4-8) that the examiner's rejection was based upon the Figure 4 embodiment of Stretch's strainer and not the Figure 3 embodiment of Stretch's strainer. Thus, one difference between the Figure 4 embodiment of Stretch's strainer and the claimed subject matter is that the cup-shaped body has an upstanding smooth **uncorrugated** outer peripheral wall. In the rejections under appeal, the examiner has not made any determination that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the Figure 4 embodiment of Stretch's strainer to have an upstanding smooth uncorrugated outer peripheral wall. Thus, the examiner

has not determined that the claimed subject matter would have been obvious under 35 U.S.C. § 103.

Pasman teaches a strainer 24 having an upstanding corrugated outer peripheral wall 25 with perforations 28a located in the wall 25 at locations spaced from the wall of the supporting body 13. Pasman also teaches that the strainer 24 may be made with a smooth circumferential wall instead of the corrugated wall. It is our opinion that Pasman would not have suggested modifying Stretch's strainer to include an upstanding smooth uncorrugated outer peripheral wall with a plurality of slots in the outer peripheral wall for draining water. While Pasman may have suggested modifying Stretch's Figure 4 strainer to include an upstanding smooth uncorrugated outer peripheral wall, such a modification of Stretch merely results in the strainer shown in Figure 3 of Stretch. In our view, Pasman's teaching that his strainer 24 may be made with a smooth circumferential wall instead of the corrugated wall would have also resulted in the omission of the perforations 28a in the modified strainer.

In our view, the only suggestion for modifying Stretch to include an upstanding smooth uncorrugated outer peripheral wall with a plurality of slots in the outer peripheral wall for draining water stems from hindsight knowledge derived from the appellants' own disclosure.² The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 17, 18 and 21 to 27 under 35 U.S.C. § 103 is reversed.

CONCLUSION

² We have also reviewed the other applied prior art references (i.e., Shobe and Ficener) but find nothing therein which makes up for the deficiencies of Stretch and Pasman discussed above.

To summarize, the decision of the examiner to reject
claims 17, 18 and 21 to 27 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JOHN F. GONZALES)	
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